



Docket No.: 200316482-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:

Antony M. Justin

Application No.: 10/809,151

Confirmation No: 7395

Filed: March 25, 2004

Art Unit: 2876

For: Information Card

Examiner: Kumiko C. Koyama

**APPELLANT'S BRIEF**

MS Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This brief, in compliance with 37 C.F.R. § 41.37, is in furtherance of the Notice of Appeal filed under 37 C.F.R. § 41.31 on July 6, 2006.

The fees required under § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees therefore are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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This brief contains items under the following headings as required by 37 C.F.R. § 41.37:

- I. Real Party in Interest
- II. Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

The final page of this brief bears the attorney's signature.

## **I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is the Hewlett Packard Development Company, LP, a limited partnership established under the laws of the State of Texas having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

## **II. RELATED APPEALS AND INTERFERANCES**

Appellant filed a Pre-Appeal Brief Request for Review on July 10, 2006. A copy of the decision rendered by the Panel is included in the appendix to this Appeal Brief.

## **III. STATUS OF CLAIMS**

- A. Total Claims: 1-28
- B. Current Status of Claims:
  - 1. Claims canceled: none
  - 2. Claims withdrawn: none
  - 3. Claims pending: 1-28
  - 4. Claims allowed: none
  - 5. Claims rejected: 1-28
  - 6. Claims objected to: 1, 4, and 13
- C. Claims on Appeal: 1-28

## **IV. STATUS OF AMENDMENTS**

Appellant filed a Pre-Appeal Request for Review on July 6, 2006 in response to a Final Office Action mailed on May 2, 2006. The Pre-Appeal Request for Review contained no claims amended, added, or cancelled. The Panel responded to the Pre-Appeal Request for Review on August 7, 2006 requiring an Appeal Brief in accordance with 37 C.F.R. 41.37.

Appellant is filing a Supplement to the Appeal Brief requesting amendments to dependent claims 14 and 15. The Appellant requests the amendments have been made to put the rejected claims in better form for consideration on appeal.

In addition, regarding the claim objections for claims 1, 4, and 13, Applicant will happily modify the objected to claims according to the Examiner's helpful suggestions upon favorable disposition of the present appeal.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

### Independent Claim 1

Independent claim 1 recites an information card 100 including a processor 102 within the card 100, a memory 104 within the card 100 and coupled to the processor 102, wherein the memory 104 includes a variety of user information including social security number 356, driver license information 356, and bank account information 362 (page 2, lines 12-15; Figure 1A, Figure 3B). The information card 100 also includes an input/output (I/O) component 106 coupled to the memory 104 and processor 102 to communicate the variety of user information in a manner detectable external to the card 110 (page 2, lines 15-18; Figure 1A). The information card also includes program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing, and deleting based on user input directly 115 to the card 100 (page 10, lines 30-33; page 11, line 1; Figure 1B).

### Dependent claim 2

Claim 2 depends from independent claim 1 and recites that the I/O component 106 includes I/O components 106 that can be selected from the group including: a display on the card 110, a function key 113/115, a transceiver 270, a data port 240, an audio input/output 121, an optical reader 121, a camera 121, and a magnetic stripe 119 (page 3, lines 1-4, 11-15; Figure 1A; Figure 2).

### Dependent claim 3

Claim 3 depends from independent claim 1 and recites that the card includes a biometric identification mechanism 121 (page 2, lines 20-21; page 4, line 32 through page 5, line 6; Figure 1B).

### Independent Claim 4

Independent claim 4 recites an information card 100 including a processor 102 within the card 100, and a memory 104 within the card 100 and coupled to the processor 102, wherein the memory 104 includes a variety of user information including social security number 356, driver license information 356, and bank account information 362 (page 2, lines 12-15; Figure 1A; Figure 3B). The information card 100 also includes a number of input/output (I/O) 106 components coupled to the memory 104 and processor 102 to communicate the variety of user information in a manner detectable external to the card 110, the number of I/O components 106 including: a display 110, a function key 115, a transceiver 270, a data port 240, an audio input/output 106, an optical reader 119, a camera 123, and a magnetic stripe 119 (page 2, lines 15-18; Figure 1A; Figure 1B; page 3, lines 1-4, 11-15; Figure 2). The information card 100 also includes program instructions storable in the memory 220 and executable by the processor 210 to selectively modify the user information including updating, editing, and deleting, based on user input 230 directly to the card (page 10, lines 30-33; page 11, line 1; Figure 1A; Figure 2). The information card 100 also includes a biometric identification mechanism 121 coupled to the processor 210, the memory 220, and the I/O components 106 (page 2, lines 20-21; page 5, line 21; Figures 1A-1B; Figure 2).

### Dependent claim 5

Claim 5 depends from independent claim 4 and recites that the function key 106; 203 includes a number of alphanumeric keys and a toggle key 113 to browse menu items 115 presented on the display 110 (page 6, lines 8-12; Figures 1A-1B; Figure 2).

Dependent claim 6

Claim 6 depends from independent claim 4 and recites that the display includes a touch sensitive display 280 (page 7, lines 8-11; Figure 2).

Dependent Claim 7

Claim 7 depends from independent claim 4 and recites that the transceiver 270 can transmit the variety of user information wirelessly using a communication technology selected from the group of radiofrequency (RF) signaling, infra-red (IR) signaling, cellular technology, bluetooth technology, and microwave technology (page 18, lines 17-21; Figure 2; page 22, line 12).

Dependent claim 8

Claim 8 depends from independent claim 4 and recites that the biometric identification mechanism 121 includes a biometric identification mechanism selected from the group of: a hand writing on a touch sensitive display, a voice received on the audio input/output, a finger print sensor, a blood analysis DNA sensor, a neural network sensor, an odorant sensor, and an iris scan (page 5, lines 2-6; Figure 1A).

Dependent claim 9

Claim 9 depends from independent claim 4 and recites that the variety of user information further includes: a membership identification, a password, a tax identification, and a medical record (page 24, lines 8-13; page 25, line 9).

Dependent claim 10

Claim 10 depends from independent claim 4 and recites that the memory includes instructions to cause the transceiver to transmit and receive the variety of user information with an external device (page 20, lines 8-11, 20-23).

Dependent claim 11

Claim 11 depends from independent claim 4 and recites that the memory includes instructions executable upon receiving user selectable input to place information relating to a particular item among the variety of user information on the magnetic strip (page 11, lines 11-16).

Dependent claim 12

Claim 12 depends from independent claim 4 and recites that the memory includes instructions executable to update the variety of user information based on input to the number of I/O components (page 2, lines 17-20).

Independent Claim 13

Independent claim 13 recites an information card 100 including a processor 102 within the card 100 and a memory 104 within the card 100 and coupled to the processor 102, where the memory 104 includes a variety of user information including a social security number 356, a driver license record 356, a bank account record 362, a membership identification, a password, a government record 325, and a medical record 332 (page 2, lines 12-15; Figure 1A; page 24, lines 8-13; Figure 3B). The information card 100 also includes a number of input/output (I/O) components 106, coupled to the memory 104 and processor 102 and program instructions storable in the memory 104 and executable by the processor 102 to selectively modify the variety of user information, including updating, editing, and deleting, based on user input directly 230 to the card (page 10, lines 30-33; page 11, line 1; Figure 1A; Figure 2).

Dependent claim 14

Claim 14 depends from independent claim 13 and recites that the means includes component circuitry within the card to connect a display, a function key, a transceiver, an optical sensor, and a magnetic strip on the card (page 3, lines 1-4, lines 11-15).

Claim 14 in its amended form presented in the supplement to the appeal brief is a dependent claim on independent claim 13 that recites that the card includes component circuitry to connect a display, a function key, a transceiver, an optical sensor, and a magnetic strip on the card ((page 3, lines 1-4, lines 11-15)).

Dependent claim 15

Claim 15 depends from dependent claim 14 and recites that the means includes a set of instructions executable in response to input on the number of I/O components (page 2, lines 17-20).

Claim 15 in its amended form presented in the supplement to the appeal brief is a dependent claim dependent on dependent claim 14 that recites that the program instructions include a set of instructions executable in response to input on the number of I/O components (page 2, lines 17-20).

Dependent claim 16

Claim 16 depends from dependent claim 15 and recites that the set of instructions are executable to transmit and receive the variety of user information between the card and an external device (page 20, lines 8-11, 20-23).

Dependent claim 17

Claim 17 depends from dependent claim 16 and recites that the set of instructions are executable to transmit and receive the variety of user information over a network selected from the group of: a wireless network 424, a local area network 414, a wide area network 426, and an internet protocol network 416 (page 16, lines 9-17; Figure 4A).

Dependent claim 18

Claim 18 depends from independent claim 13 and recites that the information card further includes a biometric identification mechanism 121 on the card selected from the group of: a hand writing sensor, an audio sensor, a finger print sensor, a blood analysis DNA sensor, a neural network sensor, an odorant sensor, and an eye sensor (page 5, lines 2-6; Figure 1A).

Independent Claim 19

Independent claim 19 recites a computer readable medium having instructions 210 for causing an information card to perform a method, including storing 220 a variety of user information including a social security number, a driver license record, a bank account record, a membership identification, a password, a government record, and a medical record in a memory on the card (page 2, lines 12-15; Figure 2; page 24, lines 8-13; page 25, line 9). The computer readable medium having instructions for causing an information card to perform a method also includes selectively communicating the variety of user information in a manner detectable external to the card and selectively modifying the variety of user

information, including updating, editing, and deleting, based on user input directly to the card (page 10, lines 30-33; page 11, line 1; page 20, lines 8-11, 20-23).

Dependent claim 20

Claim 20 depends from independent claim 19 and recites that the method includes selectively updating the variety of user information based on user input to a touch screen display (page 2, lines 17-20; page 13, lines 10-16).

Dependent claim 21

Claim 21 depends from independent claim 19 and recites that the method includes wirelessly receiving the variety of user information from information sources external to the information card 448 (page 18, lines 17-21; Figure 4B; page 22, line 12; page 20, lines 8-11, 20-23).

Independent Claim 22

Independent claim 22 recites a method for use of an information card including storing 220 a variety of user information including a social security number, a driver license record, a bank account record, a membership identification, a password, a government record, and a medical record in a memory on the information card (page 2, lines 12-15; Figure 2; page 24, lines 8-13). The method also includes selectively communicating the variety of user information in a manner detectable external to the information card and selectively modifying the variety of user information including updating, editing, and deleting based on user input directly to the card (page 10, lines 30-33; page 11, line 1).

Dependent claim 23

Claim 23 depends from independent claim 22 and recites that the method further includes wirelessly transmitting the variety of user information to a device external to the information card 448 (page 18, lines 17-21; Figure 4B; page 22, line 12; page 20, lines 8-11, 20-23).

Dependent claim 24

Claim 24 depends from independent claim 22 and recites that the method further includes wirelessly transmitting alert signals 127-P in a manner detectable

external to the information card 448 (page 18, lines 17-21; Figure 4B; page 22, line 12; page 20, lines 8-11, 20-23; page 17, lines 12-15; Figure 1B).

Dependent claim 25

Claim 25 depends from independent claim 22 and recites that the method further includes wirelessly transmitting control signals to a device external to the information card 448 (page 18, lines 17-21; Figure 4B; page 22, line 12; page 20, lines 8-11, 20-23).

Dependent claim 26

Claim 26 depends from dependent claim 25 and recites that the method further includes wirelessly transmitting control signals to a device 500 selected from the group of: a home appliance, a lock mechanism, and an automobile (page 20, lines 11-16; Figure 4B; page 21, lines 2-5; Figure 4C).

Dependent claim 27

Claim 27 depends from independent claim 22 and recites that the method further includes wirelessly receiving the variety of user information from a variety of information sources (page 17, lines 12-15).

Dependent claim 28

Claim 28 depends from dependent claim 27 and recites that the method further includes wirelessly receiving the variety of user information from a variety of sources selected from the group of: a banking database 430, a health database 431, a government database 432, an employment database 433, and an internet connection 448 (page 17, lines 25-32; Figure 4B).

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The first issue is whether claims 1,2, 4-7, 9-13, 15-17, and 19-28 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,884,271 to Pitroda (hereinafter "Pitroda") in view of U.S. Patent No. 4,868,376 to Lessin et al (hereinafter "Lessin").

The second issue is whether claims 3, 8, and 18 are unpatentable under 35 U.S.C. §103(a) as applied to claims 1, 4, and 13 and further in view of U.S. Patent No. 6,325,285 (hereinafter "Baratelli").

The third issue is whether claim 14 is unpatentable under 35 U.S.C. §103(a) as applied to claim 13 and further in view of U.S. Patent No. 6,293,462 to Gangi (hereinafter "Gangi") as cited by the Appellant.

## **VII. ARGUMENT**

### **REJECTIONS UNDER 35 U.S.C. § 103(a)**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

A. Rejection of claims 1, 2, 4-7, 9-13, 15-17, and 19-28 over Pitroda in view of Lessin.

Claims 1, 2, 4-7, 9-13, 15-17, and 19-28 were rejected under §103(a) as being unpatentable over Pitroda in view of Lessin. Appellant respectfully traverses the rejection of the claims, and addresses their rejection as follows.

**Independent Claims 1, 4, 13, 19, and 22**

Appellant respectfully submits that the cited references do not support a proper *prima facie* case of obviousness, as, besides other things, neither Pitroda nor Lessin, either independently or in combination, teach or suggest each and every element in independent claims 1, 4, 13, 19, and 22. For example, Appellant is unable to find a teaching or a suggestion of modifying the variety of user information, including updating, editing, and deleting, based on **user input directly to the card**, as provided in each of Appellant's independent claims.

In the Final Office Action, the Examiner admits that Pitroda fails to teach all of the limitations of Applicant's claims (Final Office Action, page 3). For example, the Examiner admits that Pitroda does not disclose "program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing and deleting, based on user input directly to the card." (Final Office Action, page 3).

The Examiner then relies on Lessin to cure the deficiencies of Pitroda in stating:

Lessin also teaches that if the cardholder selects the change PIN function, the cardholder is prompted to enter the current PIN by the display depicted in box (col 13, lines 20-22). The cardholder is prompted for the new PIN he wishes to enter by displays. After the new PIN is entered, the new PIN entered, the cardholder is prompted to reenter the new PIN by displays (col 13, lines 29-32). The cardholder re-enters the new PIN correctly, the current PIN is replaced with the new PIN and the cardholder is informed of this by the display at box (col 13, lines 45-48). (Final Office Action, pages 3-4).

The Examiner then concluded that "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Lessin to the teachings of Pitroda in order to customize the card according to the user such that the card is user specific and therefore, the card always contains the most recent information as well as providing enhanced security by personalizing the card." (Final Office Action, page 4).

Appellant respectfully submits that changing a PIN as described in Lessin is not equivalent to "**modifying the variety of user information**, including updating, editing, and deleting, based on user input directly to the card" as recited in each of the Appellant's independent claims.

In the Appellant's specification, the Appellant has defined the "variety of user information" to include such items as "a social security number, a driver license record, and a bank account record". (Page 2, lines 12-15). On the other hand, Lessin teaches that the application programs include "a cardholder notepad application, set time application, set date application, change pin application, credit/purchase application, transportation application and calculator emulator application program." (col. 10, lines 30-34). Lessin does not appear to teach or suggest an information card including user information such as a social security number, driver license record, or a bank account record.

In addition, although Lessin appears to teach that the cardholder can directly change the PIN, the PIN is used only for security measures (col. 4, lines 27-29) which does not equate to the user information as defined by the Applicant. Additionally, the Examiner has acknowledged that all other applications, excepting the PIN, are only modifiable by the card issuer in stating:

the application routine program can be changed, removed or deleted according to the ITC cardholder's needs by the issuer of the card (col 10, lines 25-30).  
Lessin teaches that the application programs may only be input by authorized manufacturers o[r] issuers of the ITC (col 3, lines 66-68)." (Final Office Action, page 3) (emphasis added).

From this, Lessin appears to teach that the PIN secures access to the card by having the cardholder enter the PIN to identify that the person entering the PIN is in

fact the intended cardholder. However, Lessin does not appear to teach that the cardholder can **modify the variety of user information**, including updating, editing, and deleting, based on user input directly to the card, as provided in independent claims 1, 4, 13, 19, and 22. This aspect of the Applicant's claims provides particular utility to embodiments of the invention since the user information can include such a variety of user information, e.g., a social security number, bank account information, and/or driver's license record, as discussed above.

*No suggestion or Motivation to Modify or Combine Documents*

As discussed above, the Examiner admits that Pitroda "fails to teach program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing and deleting, based on user input directly to the card." (Final Office Action, page 3). The Examiner then asserts that the teachings of Lessin make it

obvious to an artisan of ordinary skill in the art at the time of the invention was made to integrate the teachings of Lessin to the teachings of Pitroda in order to customize the card according to the user such that the card is user specific and therefore, the card always contains the most recent information as well as providing enhanced security by personalizing the card. (Final Office Action, page 4).

Appellant respectfully submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

With respect to the nature of the problem to be solved, Pitroda does not teach or suggest that there is a problem that would require a program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing, and deleting, based on user

input directly to the card. Pitroda looks to provide a universal electronic transaction card (UET card) to serve as a number of different credit cards, bank cards, identification cards, employee cards, medical and health care management cards and the like that can have information transferred to and from the UET card and a personal computer or a mainframe computer. Lessin, on the other hand, looks to provide an intelligent transaction card (ITC) that can keep track of the cardholder's banking activities, to charge a purchase, or to identify the cardholder in order to gain access into a secured area.

In addition, Pitroda states that the UET card can include "security means for preventing unauthorized use of the universal electronic transaction card and for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction card." (col. 4, lines 10-14). Since Lessin appears to teach that a user can change his or her PIN based on user input, and that Lessin appears to teach that this feature is an added security measure to prevent unauthorized users from accessing the information in the ITC, one skilled in the art would not look from Pitroda to Lessin since Pitroda already includes security means for preventing unauthorized use of the UET card. Therefore, there is no need to modify Pitroda with Lessin to increase security of the card, since Pitroda already includes security means in the UET card.

Also, since Lessin appears to teach that the ability to change the PIN is an added security measure, and the PIN does not appear to be equivalent to "user information" as it is defined in the Appellant's specification, one skilled in the art would not look to modify Pitroda with Lessin since Lessin does not appear to teach program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing and deleting, based on user input directly to the card, as provided in Appellant's independent claims. Since Lessin does not appear to teach selectively modifying the variety of user information, including updating, editing, and deleting, based on user input directly to the card, Lessin does not cure the deficiencies of Pitroda.

Moreover, Applicant respectfully submits that the Pitroda and Lessin references are not combinable in that Lessin teaches away from the Applicant's

claimed invention and that combining the references would destroy the stated purpose of Lessin. (MPEP 2143.01). For example, Lessin states:

The application programs may **only** be input by authorized manufacturers or issuers of the ITC. This secures the ITC against unauthorized access and **programming or reprogramming**. The application programs are preferably input by the issuer of the card through the input/output ports. For example, if the ITC is used for payment of public transportation, the transportation authority would load the application into the ITC and issue the card to the cardholder. (Col. 3, line 67-Col.4, line 7).

Therefore, Applicant respectfully submits that although Lessin appears to describe that a cardholder can change a PIN directly, Lessin actually teaches away from allowing the user to modify the variety of user information directly and that allowing the user to do so would defeat the intent of Lessin. Hence, the references do not describe, teach, or suggest, either independently or in combination, that a cardholder can "modify the variety of user information" as recited in each of the Applicant's independent claims and as defined in the Applicant's specification as filed.

As such, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) for independent claims 1, 4, 13, 19, and 22, as well as those claims which depend therefrom.

B. Rejection of claims 3, 8, and 18 over Pitroda in view of Lessin and further in view of Baratelli.

Claims 3, 8, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda in view of Lessin as applied to claims 1, 4, and 13 and further in view of U.S. Patent No. 6,325,285 (hereinafter "Baratelli"). Appellant respectfully traverses the rejection of the claims, and addresses their rejection as follows.

Claims 3, 8, and 18 depend from independent claims 1, 4, and 13, respectively. For the reasons presented above, Applicant believes these independent claims are allowable over Pitroda and Lessin. The Examiner relies on Baratelli to

teach "a biometric identification mechanism." However, Baratelli does not appear to cure the deficiencies of Pitroda in view of Lessin, as discussed above, with respect to the ability to "modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card", as provided in independent claims 1, 4, and 13. Applicant therefore believes that the rejection under 35 U.S.C. §103(a) to be improper, and respectfully requests that it be reversed.

C. Rejection of claim 14 in view of Pitroda in view of Lessin and further in view of Gangi.

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Pitroda in view of Lessin as applied to claim 13 and further in view of U.S. Patent No. 6,293,462 to Gangi (hereinafter "Gangi"). Appellant respectfully traverses the rejection of the claims, and addresses their rejection as follows.

Claim 14 depends from independent claim 13. For the reasons presented above, Applicant believes that independent claim 13 is allowable over Pitroda and Lessin. The Examiner relies on Gangi and Hasegawa to teach "a card having an optical sensor and a magnetic strip." However, Gangi and Hasegawa do not appear to cure the deficiencies of Pitroda in view of Lessin, as discussed above, with respect to the ability to "modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card", as provided in independent claim 13. Applicant therefore believes that the rejection under 35 U.S.C. §103(a) to be improper, and respectfully requests that it be reversed.

The Examiner is invited to telephone Applicant's attorney, Edward J. Brooks, III at (612) 236-0120 with regard to this matter.

**CERTIFICATE UNDER 37 C.F.R. §1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: **MS APPEAL BRIEF-PATENTS** Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450, on this 51<sup>st</sup> day of October, 2005.

Name

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*10/5/2005*

## VIII. CLAIMS APPENDIX

### The Claims on Appeal

1. (Previously Presented) An information card, comprising:
  - a processor within the card;
  - a memory within the card and coupled to the processor, wherein the memory includes a variety of user information including social security number, driver license information, and bank account information;
  - an input/output (I/O) component, coupled to the memory and processor, to communicate the variety of user information in a manner detectable external to the card; and
  - program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card.
2. (Original) The card of claim 1, wherein the I/O component includes I/O components selected from the group of:
  - a display on the card;
  - a function key;
  - a transceiver;
  - a data port;
  - an audio input/output;
  - an optical reader;
  - a camera; and
  - a magnetic stripe.
3. (Original) The card of claim 1, wherein the card includes a biometric identification mechanism.
4. (Previously Presented) An information card, comprising:
  - a processor within the card;

a memory within the card and coupled to the processor, wherein the memory includes a variety of user information including social security number, driver license information, and bank account information;

a number of input/output (I/O) components, coupled to the memory and processor, to communicate the variety of user information in a manner detectable external to the card, the number of I/O components including,

- a display;
- a function key;
- a transceiver;
- a data port;
- an audio input/output;
- an optical reader;
- a camera;
- a magnetic stripe;

program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card; and

a biometric identification mechanism coupled to the processor, the memory, and the I/O components.

5. (Original) The card of claim 4, wherein the function key includes a number of alphanumeric keys and a toggle key to browse menu items presented on the display.

6. (Original) The card of claim 4, wherein the display includes a touch sensitive display.

7. (Original) The card of claim 4, wherein the transceiver can transmit the variety of user information wirelessly using a communication technology selected from the group of radio frequency (RF) signaling, infra-red (IR) signaling, cellular technology, bluetooth technology, and microwave technology.

8. (Original) The card of claim 4, wherein the biometric identification mechanism includes a biometric identification mechanism selected from the group of:

- a hand writing on a touch sensitive display;
- a voice received on the audio input/output;
- a finger print sensor;
- a blood analysis DNA sensor;
- a neural network sensor;
- an odorant sensor; and
- an iris scan.

9. (Original) The card of claim 4, wherein the variety of user information further includes:

- a membership identification;
- a password;
- a tax identification; and
- a medical record.

10. (Original) The card of claim 4, wherein the memory includes instructions to cause the transceiver to transmit and receive the variety of user information with an external device.

11. (Original) The card of claim 4, wherein the memory includes instructions executable upon receiving user selectable input to place information relating to a particular item among the variety of user information on the magnetic strip.

12. (Original) The card of claim 4, wherein the memory includes instructions executable to update the variety of user information based on input to the number of I/O components.

13. (Previously Presented) An information card, comprising:  
a processor within the card;

a memory within the card and coupled to the processor, wherein the memory includes a variety of user information including a social security number, a driver license record, a bank account record, a membership identification, a password, a government record, and a medical record;

a number of input/output (I/O) components, coupled to the memory and processor; and

program instructions storable in the memory and executable by the processor to selectively modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card.

14. (Original) The card of claim 13, wherein the means includes component circuitry within the card to connect a display, a function key, a transceiver, an optical sensor, and a magnetic strip on the card.

15. (Original) The card of claim 14, wherein the means includes a set of instructions executable in response to input on the number of I/O components.

16. (Original) The card of claim 15, wherein the set of instructions are executable to transmit and receive the variety of user information between the card and an external device.

17. (Original) The card of claim 16, wherein the set of instructions are executable to transmit and receive the variety of user information over a network selected from the group of:

- a wireless network;
- a local area network;
- a wide area network; and
- an internet protocol network.

18. (Original) The card of claim 13, further including a biometric identification mechanism on the card selected from the group of:

- a hand writing sensor;
- an audio sensor;
- a finger print sensor;
- a blood analysis DNA sensor;
- a neural network sensor;
- an odorant sensor; and
- an eye sensor.

19. (Previously Presented) A computer readable medium having instructions for causing an information card to perform a method, comprising:

- storing a variety of user information including a social security number, a driver license record, a bank account record, a membership identification, a password, a government record, and a medical record in a memory on the card;

- selectably communicating the variety of user information in a manner detectable external to the card; and

- selectably modifying the variety of user information, including updating, editing, and deleting, based on user input directly to the card.

20. (Original) The medium of claim 19, wherein the method includes selectably updating the variety of user information based on user input to a touch screen display.

21. (Original) The medium of claim 19, wherein the method includes wirelessly receiving the variety of user information from information sources external to the information card.

22. (Previously Presented) A method for use of an information card, comprising:

- storing a variety of user information including a social security number, a driver license record, a bank account record, a membership identification, a password, a government record, and a medical record in a memory on the information card;

- selectably communicating the variety of user information in a manner detectable external to the information card; and

selectably modifying the variety of user information, including updating, editing, and deleting, based on user input directly to the card.

23. (Original) The method of claim 22, further including wirelessly transmitting the variety of user information to a device external to the information card.

24. (Original) The method of claim 22, further including wirelessly transmitting alert signals in a manner detectable external to the information card.

25. (Original) The method of claim 22, further including wirelessly transmitting control signals to a device external to the information card.

26. (Original) The method of claim 25, further including wirelessly transmitting control signals to a device selected from the group of:

- a home appliance;
- a lock mechanism; and
- an automobile.

27. (Original) The method of claim 22, further including wirelessly receiving the variety of user information from a variety of information sources.

28. (Original) The method of claim 27, further including wirelessly receiving the variety of user information from a variety of information sources selected from the group of:

- a banking database;
- a health database;
- a government database;
- an employment database; and
- an internet connection.

## **IX. EVIDENCE APPENDIX**

No evidence is submitted.

## **X. RELATED PROCEEDINGS APPENDIX**

Appellant respectfully submits a supplement to the Appeal Brief containing a draft of dependent claims 14 and 15 presented in better form for consideration on appeal.

In addition, Appellant attaches a copy of the Panel Decision rendered in response to Appellant's Pre-Appeal Request for Review.



### **Amendment Supplement to the Appeal Brief**

The following amendment is requested under §1.116 to dependent claims 14 and 15, as previously presented, to put the rejected claims in better form for consideration on appeal.

14. (Currently Amended) The card of claim 13, wherein the card ~~means~~ includes component circuitry ~~within the card~~ to connect a display, a function key, a transceiver, an optical sensor, and a magnetic strip on the card.
  
15. (Currently Amended) The card of claim 14, wherein the program instructions ~~means~~ includes a set of instructions executable in response to input on the number of I/O components.



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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Application Number</b> 	Application/Control No.	Applicant(s)/Patent under Reexamination
	10/809,151 ✓	JUSTIN, ANTONY MANOJ
Kumiko Koyama	Art Unit 2876	

Document Code - AP.PRE.DEC

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 7/10/2005.

1.  **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- The request does not include reasons why a review is appropriate.
- A proposed amendment is included with the Pre-Appeal Brief request.
- Other: \_\_\_\_\_

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2.  **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-28

Claim(s) withdrawn from consideration: \_\_\_\_\_

3.  **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4.  **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Sandy Soprano   
 (2) Kumiko Koyama 

(3) Jared Fureman 

(4) \_\_\_\_\_